

## REMARKS

Claims 59-73 and 75 are currently pending in this application. Applicants previously cancelled claim 74, but reserved the right to re-file the claim in a later application. For each of the following reasons, Applicants believe that each of the pending claims is allowable.

### **The November 3, 2006 Office Action**

Claims 59, 67-68, 73 and 75 were rejected under 35 USC § 102 as being anticipated by Kelsey (USP 2,430,229). Claims 59-73 and 75 were rejected under 35 USC § 103 as being obvious in light of varying combinations of Miyahra (USP 4,447,677), Killion (USP 4,677,679) and Kelsey (USP 2,430,229).

For the reasons set forth below, and for all the reasons provided in response to previous Office Actions, Applicants submit that none of the cited references, whether taken alone or in combination, teach or suggest an “insert earphone providing a high fidelity response without requiring a long flexible tube between the hollow tubular portion of the housing and the resilient sealing member” as recited in independent claim 59.

In connection with the anticipation rejection based on Kelsey, the Office stated that “Kelsey does not specifically teach that the earphone provides a high fidelity response as claimed[,]” however, “[s]ince Kelsey includes all the limitations of the insert earphone, the earphone of Kelsey has the characteristics such as a high fidelity response as claimed in claim 59.” (See, e.g., *Office Action*, pp. 3, 5.) In other words, the Office has taken the position that because certain elements are disclosed in Kelsey, other, undisclosed, elements must also be present. Applicants submit, however, that the earphone disclosed in Kelsey does not provide a high fidelity response, and that it is improper to read such a requirement into Kelsey. Further, a typical earphone in the 1940’s using the construction shown in Kelsey (Kelsey was filed in 1943) would not have been capable of providing a high-fidelity response because the bandwidth of such earphones was typically only 3-4 kHz, well below that required to be considered high-fidelity. The Office’s position also effectively ignores the limitation in claim 59 of “the

insert earphone providing a high fidelity response[.]” thereby rendering the limitation meaningless. Applicants submit that the identified limitation from claim 59 is not meaningless, and should not be ignored. Applicants submit, therefore, that claim 59 cannot be anticipated by Kelsey, which does not teach or suggest an “insert earphone providing a high fidelity response”.

In connection with an obviousness rejection based on Miyahra, the Office took the same exact position discussed above in regard to Kelsey. (See, e.g., *Office Action*, pp. 6, 8.) For the reasons discussed above, Applicants submit that the Office’s position is not tenable. Further, a typical earphone in the 1980’s using the construction shown in Miyahra (Miyahra was filed in 1982) would not have been capable of providing a high-fidelity response because the bandwidth of such earphones was typically only 4-6 kHz, well below that required to be considered high-fidelity. Applicants submit, therefore, that claim 59 cannot be rendered obvious by Miyahra, which does not teach or suggest an “insert earphone providing a high fidelity response”.

The Office also combined Kelsey and Killion to form the basis of an obviousness rejection, stating that it would have been obvious for “the network circuit or filter [electrical equalization network 40], as taught by Killion, to be connected to the receiver of Kelsey for a more accurate frequency response or a high-fidelity frequency response.” (See, e.g., *Office Action*, p. 5.)

Although one of the stated objects of the system described in Killion is to provide a more accurate frequency response (see, e.g., *Killion*, 3:42-50), the system described in Killion does not simply pair an electrical equalization network 40 and a receiver/transducer 21 to provide a more accurate frequency response. Rather, the system described in Killion utilizes, among other things, an electrical equalization network 40, a receiver/transducer 21, and a **sound tube 7** in order to provide a more accurate frequency response. More importantly, Killian does not, whether taken alone or in combination with any other cited reference(s), teach or suggest the use of an electrical equalization network and receiver/transducer combination in the absence of a **sound tube** in order to provide a more accurate frequency response.

Specifically, the system disclosed in Killion has a main sound tube 7 that connects a base unit 2 to an ear piece 8. (See, e.g., *Killion*, Abstract; 4:25-28.) The base unit 2 includes a case 3 that houses the electrical equalization network 40 and a receiver/transducer 21. (See, e.g., *Killion*, 5:20-35.) The sound tube 7 of the preferred embodiment has a length (292 mm) that provides an acoustic time delay that is convenient for “ABR time-base offset calibration.” (See, e.g., *Killion*, 4:29-40; 4:67-5:4; 5:51-54.) That is, the sound tube 7 is an integral part of the system described in Killion, as further shown by Killion’s inclusion of the sound tube 7 (along with the electrical equalization network 40 and the receiver/transducer 21) in a description of a “preferred arrangement of components” (*Killion*, 5:20-35), and by Killion’s statement that “[t]he design of the equalization networks will be best understood from examples of networks which have been constructed and used in conjunction with particular types of receivers or transducers, and with tubing and other acoustic components having configurations as illustrated and having dimensions as described above” (*Killion*, 6:6-11 (emphasis added)).

Killion discloses, therefore, a system that utilizes, among other things, an electrical equalization network 40, a receiver/transducer 21, and a sound tube 7, which system provides a more accurate frequency response. Killian does not, whether taken alone or in combination with any other cited reference(s), teach or suggest the use of an electrical equalization network and receiver/transducer combination in the absence of a sound tube in order to provide a more accurate frequency response. Further, the sound tube is integral to the proper functioning of the system described in Killion.

Thus, there is no teaching or suggestion that combining the electrical equalization network of Killion with the receiver of Kelsey in the absence of a sound tube would provide a high fidelity response. Further, it would not be evident to one skilled in the art to combine Killion and Kelsey in such a manner because Killion teaches that a sound tube is integral to the proper functioning of the system described in Killion. Killion and Kelsey cannot, therefore, properly be combined to form the basis of an obviousness rejection for claim 59, which recites an “insert earphone providing a high fidelity response without requiring a long flexible tube between the hollow tubular

portion of the housing and the resilient sealing member[.]” Applicants submit, therefore, that claim 59 cannot be rendered obvious by the combination of Killion and Kelsey.

In connection with an obviousness rejection based on Miyahra and Killion, the Office took the same exact position discussed above in regard to Kelsey and Killion. (See, e.g., p. 8.) For the same reasons discussed above, Applicants submit that claim 59 cannot be rendered obvious by the combination of Miyahra and Killion.

Applicants also request reconsideration of the pending claims in light of the evidence of non-obviousness previously presented and referenced below.

**Previous Office Actions and Responses, Official Notice and Objective Indicia of Non-Obviousness**

The Office previously rejected the pending claims under 35 USC § 103 as being obvious in light of varying combinations of McCabe (USP 3,671,685), Miyahra (USP 4,447,677), Killion (USP 4,677,679) and Kelsey (USP 2,430,229).

In its July 25, 2005 response, Applicants provide a detailed explanation as to why the pending claims are patentable over these references. At the heart of Applicants’ argument is that the combination of references cited in the Office Action does not teach, among other things, “the earphone providing a high fidelity response without requiring a long flexible tube between the hollow tubular portion of the housing and the resilient sealing member.”

On January 26, 2006, the Office issued a second rejection. In this rejection the Office again reiterated that none of the references “teach that the earphone provides a high fidelity response as claimed.” However, the Office claimed connecting a hearing aid to a circuitry or an amplifier for providing an output signal with relatively high fidelity was known in the art. The Office Action, however, provided no support for this position. And while the Examiner obviously completed a thorough and detailed search of the prior art, the Examiner’s search did not yield a single reference that the Examiner could cite

to for this proposition. Moreover, because the subject matter is not of such “notorious character” that it is “capable of instant and unquestionable demonstration as being well-known,” Applicants assert that the Examiner cannot take official notice of this fact under MPEP 2144.03. Accordingly, the Applicants requested that the Office provide a reference(s) to support the Office’s position if the Office intends to maintain any rejection based on the assertion.

The November 3, 2006 Office Action reiterated the Office’s above-described position without providing a reference(s) to support that position. For all the reasons above, Applicants again request that the Office provide a reference(s) to support the Office’s position if the Office intends to maintain any rejection based on the official notice assertion.

Moreover, the Office has apparently ignored Applicants’ submissions regarding non-obviousness. One important indicator of the non-obviousness of an invention is the failure of others to achieve the invention. See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 36, 148 U.S.P.Q. 459 (1966). The Applicants are believed to be the first to have successfully designed and built a high-fidelity insert earphone. The Applicants’ unique combination of elements compensates for loss of external ear resonance and results in an earphone that achieves high fidelity reproduction. To Applicants’ knowledge, none of the prior art references, either alone or in combination, achieve high fidelity reproduction as does Applicants’ invention.

Another important indicator of the non-obviousness of an invention is praise of the invention by experts. See, e.g., *Litton Systems Inc. v. Honeywell, Inc.*, 39 U.S.P.Q.2d 1321, 1327 (1996). As evidenced by the reviews previously submitted, Applicants’ invention has been met with high praise from experts in the audio industry. In fact, many experts believe that Applicants’ earphones are perhaps the best available on the market and succeed where many others have failed.

Clearly such evidence further demonstrates the non-obviousness of Applicants' invention and supports allowability of the pending claims. The Office, however, never addressed, and thus apparently never gave any weight to, Applicants' evidence of non-obviousness. Applicants request reconsideration of the pending claims in light of this evidence.

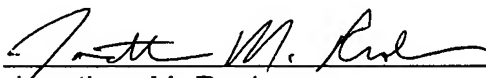
### **Conclusion**

In view of the foregoing, it is respectfully submitted that the pending claims define allowable subject matter over the art of record, especially in light of the overwhelming evidence of non-obviousness. The Office is invited to come forth with additional references that provide support for its rejections. However, if unable to do so, Applicants respectfully request that the Office withdraw its rejections.

Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the telephone number listed below.

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Respectfully submitted,

  
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